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09/552,815	04/20/2000	Steven G. Goldstein	50N3483/1333	4648

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Gregory J. Koerner
Simon & Koerner LLP
10052 Pasadena Avenue, Suite B
Cupertino, CA 95014

EXAMINER
WALLERSON, MARK E

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2622	14

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/552,815	Applicant(s) Goldstein et al
	Examiner Mark Wallerson	Art Unit 2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Mar 4, 2003* .

2a) ☒ This action is **FINAL.** 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-65* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-65* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

Part III DETAILED ACTION

Notice to Applicant(s)

1. This action is responsive to the following communications: amendment filed on **3/4/2003.**

2. This application has been reconsidered. Claims 1-65 are pending.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1, 2, 3, 5, 6, 11, 12, 13, 14, 15, 16, 17, 22, 23, 24, 25, 26, 28, 29, 34, 35, 36, 37, 38, 39, 40, 45, 46, and 47 are rejected under 35 U.S.C. 102(e) as being anticipated by Bell et al (Bell) (U. S. 6,147,742).

With respect to claims 1, 3, 5, 12, 15, 22, 23, 24, 26, 28, 35, 38, 45, and 46, Bell discloses a system (figure 1) for transferring image data to a service provider (20) comprising an image source (camera 26); and an image pump (which reads on the order manager) (22) configured to receive image data from the image source (column 3, lines 60-67) by a hard-wired connection (net), and responsively provide the image data to the service provider (the abstract), the image pump implemented separately from the image source (figure 1) for receiving the image data (column 3, lines 60-62); the image pump being implemented without an internal processor (figure 1) (there is no indication in Bell that the order manager contains a processor).

With respect to claims 2 and 25, Bell discloses a photofinishing system wherein audio data is coupled with the text/image data prior to being sent to the photofinisher (column 3, line 60 to column 4, line 17).

With regard to claims 6, 11, 29, and 34, Bell discloses the data source stores the data on removable storage (column 3, line 60 to column 4, line 3).

With respect to claims 13, 16, 36, and 39, Bell discloses the image pump configures the data to conform to a format required by the service provider (column 2, lines 30-38).

With regard to claims 14, 17, 37, 40, and 47, Bell discloses the image pump includes customer information that is communicated to the service provider (column 5, lines 1-11).

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 48, 49, 50, 51, 55, 56, 58, 59, 60, and 61 are rejected under 35 U.S.C. 102(e) as being anticipated by Enomoto.

With respect to claim 48, Enomoto discloses capturing image data utilizing an image source (20 or 21); sending the image data to an image pump (11); attaching customer account information to the image data (column 3, line 64 to column 4, line 4); sending the image data and customer account information to the service provider (column 6, lines 44-50); determining if the image data and customer information have errors (column 7, lines 4-8), and requesting the image pump to re-transmit the image data and customer information if errors are detected (column 7,

lines 4-8); providing services by the service provider (column 7, lines 23-40, and returning a final product to the user, along with a bill (column 7, line 41 to column 8, line 12).

With respect to claims 49, 50, and 51, Enomoto discloses a system for transferring image data to a service provider (12), comprising an image source (20 or 21), and an image pump (which reads on computer 11) configured to receive the image data from the image source by a hard-wired connection (column 6, lines 23-32), and provide the image data to the service provider (column 6, lines 44-50), the image pump (11) being implemented separately from the image source (20 or 21).

With regard to claims 55 and 56, Enomoto discloses allowing a user to view and select individual images to be processed (column 6, lines 44-50) and attaching specific instruction to the images (column 6, lines 44-64).

With respect to claims 58 and 59, Enomoto discloses attaching customer information to the data (column 3, line 64 to column 4, line 4).

With respect to claim 60, Enomoto discloses capturing image data utilizing an image source (20 or 21); sending the image data to an image pump (11); attaching customer account information to the image data (column 3, line 64 to column 4, line 4); sending the image data and customer account information to the service provider (column 6, lines 44-50); determining if the image data and customer information have errors (column 7, lines 4-8), and requesting the image pump to re-transmit the image data and customer information if errors are detected (column 7,

lines 4-8); providing services by the service provider (column 7, lines 23-40, and returning a final product to the user, along with a bill (column 7, line 41 to column 8, line 12).

With regard to claim 61, Enomoto discloses configuring the image data to conform to a format required by the service provider (column 3, lines 41-60).

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

8. Claims 62 and 64 are rejected under 35 U.S.C. 102(e) as being anticipated by Safai (U. S. 6,167,469).

With respect to claim 62 and 64, Safai discloses capturing image data by utilizing an image source (100); providing the image data to an image pump (figure 2) integral with the camera;

converting the image data to a format compatible with the service provider (column 5, lines 28-62 and column 7, lines 14-50); attaching user defined instructions and customer account information (column 7, lines 32--50 and column 15, lines 16-27); transferring the image from the image pump to the service provider (column 2, lines 1-3); reviewing the order and providing services to the user (column 15, lines 17-58).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 4 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bell in view of Cok (U. S. 6,157,436).

With respect to claims 4 and 27, Bell differs from claims 4 and 27 in that he does not clearly disclose the image source communicates with the image pump by wireless means. Cok discloses a photofinishing system wherein an image pump (170) receives data from an image source via wireless (optical) means (column 7, lines 35-40). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Bell by the teaching of Cok in order to obtain data from different sources.

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12. Claims 7, 8, 9, 10, 18, 19, 20, 21, 30, 31, 32, 33, 41, 42, 43, and 44, are rejected under 35 U.S.C. 103(a) as being unpatentable over Bell in view of Enomoto (U. S. 5,974,401).

Bell differs from claims 7, 8, 9, 10, 30, 31, 32, and 33 in that he does not clearly disclose the type of connection between the Image pump and the service provider. Enomoto discloses communicating with the service provider via a wireless (radio telephone line); hard-wired (cable); ethernet (which reads on a network such as the Internet), or a public switched telephone network (column 3, lines 21-30 and column 4, lines 61-65). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Bell wherein different transmission methods are user to transmit image data to the service provider. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Bell by the teaching of Enomoto in order to allow the service provider to receive data from different sources.

With respect to claims 18, 19, 20, 21, 41, 42, 43, and 44, Bell differs from claims 18, 19, 20, 21, 41, 42, 43, and 44 in that he does not clearly disclose the image pump has a touchscreen for displaying the image data to the user and determining user selections and transferring the selections to the service provider. Enomoto discloses the image pump (11) has a touchscreen for displaying the image data to the user (column 6, lines 44-50), and determining user selections and

transferring the selections to the service provider (column 6, lines 44-50). Therefore, it would have bee obvious to one of ordinary skill in the art at the time of the invention to have modified Bell wherein the image pump has a touchscreen for displaying the image data to the user and user selections are determined and transferred to the service provider. It would have bee obvious to one of ordinary skill in the art at the time of the invention to have modified Bell by the teaching of Enomoto in order to achieve ease of operation.

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

14. Claim 52 is rejected under 35 U.S.C. 103(a) as being unpatentable over Enomoto in view of Bell et al (Bell) (U. S. 6,147,742).

With respect to claim 52, Enomoto differs from claim 52 in that although he discloses the image source is a camera, he does not clearly disclose receiving audio data from the image source. Bell discloses a photofinishing system wherein audio data is coupled with the text/image data prior to being sent to the photofinisher (column 3, line 60 to column 4, line 17). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Enomoto wherein audio data is received from the image source. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Enomoto

by the teaching of Bell in order to allow for a variety of output media and formats as disclosed by Bell in column 2, lines 25-29.

15. Claims 53 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Enomoto in view of Bell.

With respect to claim 53, Enomoto differs from claim 53 in that he does not clearly disclose source transfer means external to the image source and image pump allows the image source to download data to the image pump and allows the image pump to upload data to the service provider. Bell discloses source transfer means (the order manager) external to the image source and image pump allows the image source to download data to the image pump and allows the image pump to upload data to the service provider (column 4, line 42 to column 5, line 60). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Enomoto by the teaching of Bell in order to simplify the system.

With respect to claim 57, Enomoto differs from claim 57 in that he does not clearly disclose that the image pump does not have a video display and a user signals the image pump to transfer data. Bell discloses an image pump (34) that does not have a video display and a user signals the image pump to transfer data (column 5, lines 1-32). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Enomoto by the teaching of Bell in order to simplify the system.

16. Claim 54 is rejected under 35 U.S.C. 103(a) as being unpatentable over Enomoto in view of Bell as applied to claim 53 above, and further in view of Cok.

With respect to claim 54, Enomoto as modified differs from claim 54 in that although he discloses transferring the data to the service provider in a cable ro wireless manner (column 4, lines 61-65), he does not clearly disclose the image source communicates with the image pump by wireless means. Cok discloses a photofinishing system wherein an image pump (170) receives data from an image source via wireless (optical) means or disk (112) and transfers the data to the photofinisher (160) by wireless, disk or cable means (column 7, lines 4-67). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Enomoto by the teaching of Cok in order to obtain data from different sources.

17. Claims 63 and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Safai in view of Enomoto.

With respect to claim 63, Safai differs from claim 63 in that he does not clearly disclose that the image source is a scanner. Enomoto discloses a scanner as an image source (20). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Safai by the teaching of Enomoto in order to vary the image sources.

With respect to claim 65, Safai discloses including customer account information (column 15, lines 17-27). Safai differs from claim 65 in that he does not disclose determining if the image data and customer information have errors, and requesting the image pump to re-transmit the

image data and customer information if errors are detected. Enomoto discloses determining if the image data and customer information have errors (column 7, lines 4-8), and requesting the image pump to re-transmit the image data and customer information if errors are detected (column 7, lines 4-8). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Safai by the teaching of Enomoto in order to improve the image system.

Response to Arguments

18. Applicant's arguments with respect to claims 1-47 have been considered but are moot in view of the new ground(s) of rejection. Additionally, the arguments with respect to claims 1 and 24 are based on newly added subject matter.

With respect to claims 48, Applicant submits that Enomoto fails to teach a service provider "reviewing said image data and said customer account information for accuracy". The Examiner respectfully disagrees.

Enomoto discloses sending print order data (which reads on the image data and said customer account information) to the photofinisher (column 6, lines 51-54). If there is any inconsistency found in the print order information by the workstation (13), the user is asked to send the order again(column 7, lines 4-13).

With respect to claim 50, the means for sending the image data from the camera to the image pump (column 6, lines 25-32) and the means for sending image data from the image pump to the service provider (a modem) (column 3, lines 26-30) are CLEARLY taught.

It is noted that Applicant has not stipulated that specific elements of claims 49 and 51 are not taught by Enomoto, since claim 49 does not claim the "reviewing" limitation.

Applicant submitted that the Examiner's analogizing the personal computer to the image pump is incorrect, is confusing. Applicant's specification clearly states that the image pump may be implemented in a personal computer (page 11, lines 16-20 of the original specification). In this regard, Applicant's argument directly contradicts his disclosure.

With respect to claim 62, Applicant submits that Safai does not disclose reviewing the image data and customer account information for accuracy, the Examiner respectfully disagrees. Safai discloses an image authentication method that is applied to the photos (image data) by the server (service provider) (column 15, line 60 to column 16, line 50).

Conclusion

19. All claims are rejected.

20. Applicant's amendment necessitated the new grounds of rejection. Accordingly, THIS ACTION IS MADE FINAL. See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Wallerson whose telephone number is (703) 305-8581.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, DC 20231

or faxed to:

(703) 872-9314 (for formal communications intended for entry)

(for informal or draft communications, such as proposed amendments to be discussed at an interview; please label such communications "PROPOSED" or "DRAFT")

or hand-carried to:

Crystal Park Two
2121 Crystal Drive
Arlington. VA.
Sixth Floor (Receptionist)

MARK WALLERSON
PRIMARY EXAMINER

Mark Wallerson